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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/825,463	04/02/2001	Geoffrey B. Rhoads	P0338	1336

23735 7590 04/18/2005

DIGIMARC CORPORATION
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EXAMINER	
PYZOCHA, MICHAEL J	

ART UNIT	PAPER NUMBER
2137	

DATE MAILED: 04/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/825,463	RHOADS, GEOFFREY B.	
	Examiner	Art Unit	
	Michael Pyzocha	2137	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 January 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *01212005*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Claims 1-20 are pending.

2. Amendment filed 01/21/2005 has been received and considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-2, 4, 6, 9, 11-12, 14, 16, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leighton (U.S. 5,949,885) and further in view of Bates et al (US 6785732).

As per claims 1 and 11, Leighton discloses a computer device having a memory in which audio or visual content may be stored (see column 3 lines 11-30), the device including software for automatically analyzing content stored in said memory for plural-bit digital watermark data (see column 3 lines 56-67), and for altering an aspect of the device's operation with

respect to said content, in accordance with detection of said watermark data (see column 6 lines 54-65).

Leighton fails to disclose this process being done automatically - without user intervention.

However, Bates et al teaches a process being done automatically (see column 6 lines 50-62).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Bates et al's teaching of automatic detection to detect the watermark of Leighton.

Motivation to do so would have been to make the process nearly transparent to the user.

As per claims 2 and 12, the modified Leighton and Bates et al system discloses the content is still image data (see Leighton column 3 lines 11-30).

As per claims 4 and 14, the modified Leighton and Bates et al system discloses the software alters device operation to signal to a user a third party has proprietary rights to the content (see Leighton column 1 lines 16-33).

As per claims 6 and 16, the modified Leighton and Bates et al system discloses the software provides at least some of the digital watermark data to a remote database, resulting in the

provision of remote information to the device that controls some aspect of its operation (see Leighton column 7 lines 36-60).

As per claims 9 and 19, the modified Leighton and Bates et al system discloses the software automatically reports detection of at lease some of the digital watermark data to a remote computer (see Leighton column 7 lines 36-60).

5. Claims 3 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Leighton and Bates et al system as applied to claims 1 and 11 above, and further in view of Mast (U.S. 5,881,287).

As per claims 3 and 13, the modified Leighton and Bates et al system fails to disclose the memory comprises a clipboard used by the device's operating system.

However, Mast teaches the use of a clipboard as memory (see column 2 lines 3-12).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to check Mast's clipboard memory with the modified Leighton and Bates et al system's watermark detection method.

Motivation to do so would have been that unlicensed data could be found in the clipboard memory (see Mast column 2 lines 3-12).

6. Claims 5 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Leighton and Bates et al system as applied to claims 1 and 11 above, and further in view of Saito (U.S. 6,182,218).

As per claims 5 and 15, the modified Leighton and Bates et al system fails to disclose the software alters a graphical display to the user to alert the user that a third party has proprietary rights to the content.

However, Saito teaches such an alteration (see column 9 lines 3-15 and Figs 3A and 3B).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to add Saito's graphical alteration to the digital content the modified Leighton and Bates et al system's method detects.

Motivation to do so would have been to allow for notification that the user is unauthorized to store, copy, or transfer the data (see Saito column 9 lines 3-15).

7. Claims 7 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Leighton and Bates et al system as applied to claims 6 and 16 above, and further in view of Biezunski et al (webpage).

As per claims 7 and 17, the modified Leighton and Bates et al system fails to disclose the information being HTML instructions.

However Biezunski et al teaches the use of HTML (see page 2).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to send the instructions of the modified Leighton and Bates et al system as HTML as described in Biezunski et al.

Motivation to do so would have been because HTML is parsable (see page 2).

8. Claims 8 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Leighton and Bates et al system as applied to claims 6 and 16 above, and further in view of Ananda (U.S. 5,495,411).

As per claims 8 and 18, the modified Leighton and Bates et al system discloses checking a watermark with a password to a user password (see column 8 lines 18-30), but fails to disclose sending any of this data to a remote database.

However, Ananda discloses sending a password to a database for comparison (see column 7 lines 13-37).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to send the watermark

password of the modified Leighton and Bates et al system to a database as described in Ananda.

Motivation to do so would have been to allow certain users access to the content (see Ananda column 7 lines 13-37).

9. Claims 10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over the modified Leighton and Bates et al system as applied to claims 1 and 11 above, and further in view of "Opening Windows and Frames" (webpage).

As per claims 10 and 20, the modified Leighton and Bates et al system fails to disclose the software, upon detection of the watermark data, causes a new box to be displayed on a display screen, the box presenting information to the user.

However, the webpage discloses displaying such a box (see page2 2-3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to display the box of the webpage when the software of the modified Leighton and Bates et al system detects a watermark.

Motivation to do so would have been to alert the user and confirm information by the user (see pages 2-3).

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2, 4, 6, 9, 11-12, 14, 16, 19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6553129 in view of Leighton.

As per claims 1 and 11, patented claim 7 discloses a computer device having a memory in which audio or visual content may be stored, the device including software for automatically analyzing content stored in said memory for plural-bit digital watermark data,

The patented claim fails to disclose altering an aspect of the device's operation with respect to said content, in accordance with detection of said watermark data.

However, Leighton discloses such a limitation (see column 6 lines 54-65).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to use Leighton's teaching of controlling a device's operation with the patented claim.

Motivation to do so would have been to prevent unauthorized copying of material.

As per claims 2 and 12, the patented claim in view of Leighton discloses the content is still image data (see Leighton column 3 lines 11-30).

As per claims 4 and 14, the patented claim in view of Leighton discloses the software alters device operation to signal to a user a third party has proprietary rights to the content (see Leighton column 1 lines 16-33).

As per claims 6 and 16, the patented claim in view of Leighton discloses the software provides at least some of the digital watermark data to a remote database, resulting in the provision of remote information to the device that controls some aspect of its operation (see Leighton column 7 lines 36-60).

As per claims 9 and 19, the patented claim in view of Leighton discloses the software automatically reports detection of at lease some of the digital watermark data to a remote computer (see Leighton column 7 lines 36-60).

2. Claims 3 and 13 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6553129 in view of Leighton and further in view of Mast (U.S. 5,881,287).

As per claims 3 and 13, the patented claim in view of Leighton fails to disclose the memory comprises a clipboard used by the device's operating system.

However, Mast teaches the use of a clipboard as memory (see column 2 lines 3-12).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to check Mast's clipboard memory with the patented claim in view of Leighton watermark detection method.

Motivation to do so would have been that unlicensed data could be found in the clipboard memory (see Mast column 2 lines 3-12).

10. Claims 5 and 15 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6553129 in view of Leighton and further in view of Saito (U.S. 6,182,218).

As per claims 5 and 15, the patented claim in view of Leighton fails to disclose the software alters a graphical

display to the user to alert the user that a third party has proprietary rights to the content.

However, Saito teaches such an alteration (see column 9 lines 3-15 and Figs 3A and 3B).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to add Saito's graphical alteration to the digital content the patented claim in view of Leighton method detects.

Motivation to do so would have been to allow for notification that the user is unauthorized to store, copy, or transfer the data (see Saito column 9 lines 3-15).

11. Claims 7 and 17 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6553129 in view of Leighton and further in view of Biezunski et al (webpage).

As per claims 7 and 17, the patented claim in view of Leighton fails to disclose the information being HTML instructions.

However Biezunski et al teaches the use of HTML (see page 2).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to send the instructions

of the patented claim in view of Leighton as HTML as described in Biezunski et al.

Motivation to do so would have been because HTML is parsable (see page 2).

12. Claims 8 and 18 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6553129 in view of Leighton and further in view of Ananda (U.S. 5,495,411).

As per claims 8 and 18, the patented claim in view of Leighton discloses checking a watermark with a password to a user password (see column 8 lines 18-30), but fails to disclose sending any of this data to a remote database.

However, Ananda discloses sending a password to a database for comparison (see column 7 lines 13-37).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to send the watermark password of the patented claim in view of Leighton to a database as described in Ananda.

Motivation to do so would have been to allow certain users access to the content (see Ananda column 7 lines 13-37).

13. Claims 10 and 20 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6553129 in view of

Leighton and further in view of Opening Windows and Frames" (webpage).

As per claims 10 and 20, the patented claim in view of Leighton fails to disclose the software, upon detection of the watermark data, causes a new box to be displayed on a display screen, the box presenting information to the user.

However, the webpage discloses displaying such a box (see page2 2-3).

At the time of the invention it would have been obvious to a person of ordinary skill in the art to display the box of the webpage when the software of the patented claim in view of Leighton detects a watermark.

Motivation to do so would have been to alert the user and confirm information by the user (see pages 2-3).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Pyzocha whose telephone number is (571) 272-3875. The examiner can normally be reached on 7:00am - 4:30pm first Fridays of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be

reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MJP

ANDREW CALDWELL
SUPERVISORY PATENT EXAMINER